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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,293

05/16/2007

Ralf Dunkel

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7590

08/12/2009

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EXAMINER

RODRIGUEZ-GARCIA, VALERIE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,293	<b>Applicant(s)</b> DUNKEL ET AL.	
	<b>Examiner</b> VALERIE RODRIGUEZ-GARCIA	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 5-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/04/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

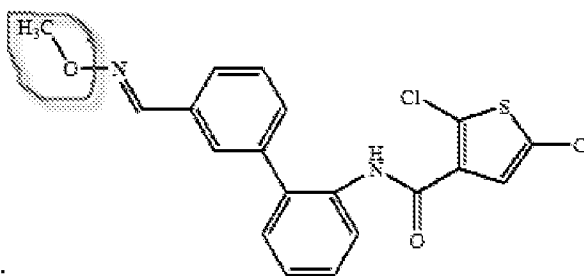
Receipt of the remarks and amendments filed on May 4, 2009 is acknowledged. Claims 1-11 are currently pending; claims 3, 5-11 have been withdrawn; claims 1, 2 and 4 are the subject of this Office Action.

#### ***Previous Claim Rejections - 35 USC § 103***

1. Claims 1-2 and 4 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,176,228 B2 (which is the equivalent for WO 02/08197).

Applicants have added a proviso into claim 1 to overcome the rejection. The proviso excludes phenyl that is only mono-substituted by  $-\text{CH}=\text{N}-\text{OCH}_3$ , however, it still includes phenyl that is substituted by  $-\text{CH}=\text{N}-\text{OCH}_2\text{CH}_3$  and when  $\text{Q}_2$  is hydroxy, propoxy, butoxy or alkoxy with longer alkyl chains.

#### *Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*



Prior art's compound:

. The

compound of the prior art differs from Applicant's compound in the substitution of chloro instead of hydrogen in the 5-position of thiophene. In the previous action it was explained that US Patent 7,176,228 B2 recites preferred substitutions on the thiophene ring and that the patent discloses hydrogen in the 5-position of thiophene. Now, the difference between the prior art and Applicant's compounds is that the prior art compound has a methyl instead of an ethyl, propyl, butyl (longer alkyl chains) or

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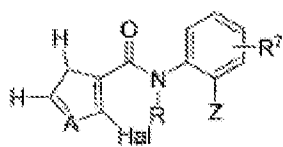
hydrogen in the oxygen of the oxime group (new limitation). Therefore, the claimed invention differs from the prior art only by a methyl (or longer alkyl chain).

*Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)*

It has been held that members of a homologous series are not patentable absent a showing of unexpected properties. *In re Henze*, 85 USPQ 261 (1950). To those skilled in the art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. *In re Henze*, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious, because one skilled in the art would have been motivated to prepare homologues of the compounds taught in the reference with the expectation of obtaining compounds which could be used as microbicides.

**Applicant's arguments**

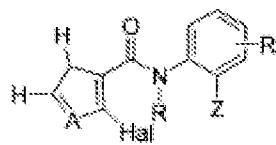
Applicant argue that claims 1, 2 and 4 as amended require a compound of the



following formula

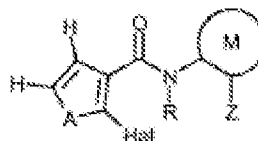
. Applicant's arguments are not persuasive. The

structure that Applicant's arguments are directed to is not the structure of claim 1.



Applicants arguments are directed to this structure:

, however, the



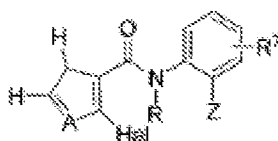
structure of instant claim 1 is the following: . The examiner has not analyzed the structure to which applicant's arguments are directed. Nevertheless, the structure of instant claim 1 is unpatentable over the structure of the prior art for the reasons discussed in the rejection above.

Therefore, the rejection is **maintained**.

### ***Previous Claim Rejections-Double Patenting***

2. Claims 1-2 and 4 were previously rejected on the ground of nonstatutory double patenting over claims 1-4 and 7-8 of U. S. Patent No. 7,208,169 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

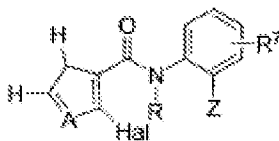
Applicants argue that the amendments to claims 1, 2 and 4 require a different



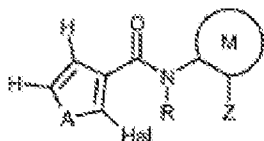
compound of the following formula and that Z1 is different to the group required in the '169 patent.

### **Applicant's arguments**

Applicant's arguments are unpersuasive. The structure that Applicant's arguments are directed to is not the structure of claim 1. Applicants arguments are



directed to this structure: , however, the structure of instant claim 1



is the following: . The examiner has not analyzed the structure to which applicant's arguments are directed. Nevertheless, the structure of instant claim 1 is unpatentable over the structure of the '169 patent because the instant claims encompass overlapping subject matter as follows: A represents S (Sulfur) or O (oxygen); M represents phenyl and wherein Z is Z1 and Z1 represents phenyl substituted with W1, wherein W1 represents "doubly attached dioxyalkylene having 1 or 2 carbon atoms".

Therefore, the double patenting rejection is **maintained**.

3. The provisional rejections of claims 1-2 and 4 on the ground of nonstatutory double patenting over claims 15-26 of copending Application No. 10/538242, claims 1-4 of copending Application No. 10/579033, claims 1-4 of copending Application No. 10/597723 and claims 1-4 of copending Application No. 12/097753 are **maintained**. Applicants have decided not to address the provisional rejections in the arguments submitted on 05/04/2009.

### ***Previous Claim Objections***

The amendments of 05/04/2009 have overcome the objection of claims 1-2 and 4 for containing non-elected subject matter. Therefore, this rejection is withdrawn.

### **Conclusion**

Claims 1, 2 and 4 are rejected. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/  
Primary Examiner, Art Unit 1626

/VALERIE RODRIGUEZ-GARCIA/  
Examiner, Art Unit 1626